

REMARKS

Applicant has carefully reviewed the Office Action mailed March 18, 2009 and offers the following remarks to accompany the above amendments.

Status of the Claims

Claims 35, 37-39, 41, 43-53, and 59-61 were previously pending. Claims 1-34, 36, 40, 42, and 54-58 were previously cancelled. Claims 35, 48, 53, and 60 have been amended to clarify that Applicant's invention relates to a first device directing a second device to obtain or receive content based on directions from the first device, without user input via the second device. Applicant notes that this limitation was previously recited in independent claims 59 and 61, but was not addressed by the Patent Office in the Office Action mailed March 18, 2009. Applicant has added new dependent claim 62 to recite further features of the first device. Accordingly, claims 35, 37-39, 41, 43-53, and 59-62 are pending.

Rejection Under 35 U.S.C. § 103(a) – Szeto and Lee

Claims 35, 37-39, 41, and 43-61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2005/0262204 A1 to Szeto et al. (hereinafter "Szeto") in view of U.S. Patent Application Publication No. 2003/0225834 A1 to Lee et al. (hereinafter "Lee"). Applicant respectfully traverses. When determining whether a claim is obvious, an Examiner must make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Applicant's invention relates to a first device that can obtain a playlist over a network, and direct a second device to receive or obtain a media item, such as a song, that is referenced in the playlist. The second device is directed by the first device, without user input at the second

device. Both Szeto and Lee, as discussed more fully herein, require user input via the second device and, consequently, cannot render obvious Applicant's claimed invention.

Szeto discloses a combined Instant Messaging (IM) and media player application (IM player) (Szeto, Fig. 3 and para. 23). The IM player interfaces with an IM server for IM messages and a media server to obtain media (*Id.* at para. 16). Szeto discloses that a first user may allow the IM server to update a second user's IM player display with the name of a song being listened to by the first user (*Id.* at para. 27). The name of the song is preferably listed as a hyperlink on the second user's IM player (*Ibid.*). The second user may activate or otherwise click on the hyperlink to cause the song to be streamed to the second user's IM player (*Ibid.*). Notably, Szeto teaches that each user must actively request the song by affirmatively selecting the hyperlink. In direct contrast, Applicant's claimed invention directs or instructs a second device to obtain or receive a song. A user need not affirmatively select a hyperlink. In fact, Applicant's claimed invention can work with second devices with which a user could not affirmatively select a hyperlink, such as a stereo receiver, a television, and the like.

The Patent Office concedes that Szeto fails to disclose a first device directing a second device to obtain or receive a song (Office Action mailed March 18, 2009, p. 3). The Patent Office suggests Lee discloses such features and asserts it would be obvious to combine the teachings of Lee with Szeto. Lee discloses a method and system for sharing dynamic content (Lee, Abstract). Lee discloses that an inviter computer may invite an invitee computer to share an audio experience (*Id.* at para 48). Lee discloses that the user of the invitee computer must accept an invitation from the inviter computer before the audio experience may be shared (*Id.* at paras. 49, 54, and 56, for example). Thus, similarly to Szeto, Lee requires user input via the second device prior to the initiation of a shared audio experience. In direct contrast, each of Applicant's independent claims require that the first device direct the second device without user input via the second device. Although this limitation was previously recited in independent claims 59 and 61, the Patent Office in its rejection of such claims stated "[c]laims 48-54 and 56-61 have similar limitations as claims 35-47; therefore, they are rejected under the same rationale" (Office Action mailed March 18, 2009, p. 4). However, that statement is not accurate because at least claims 59 and 61 included limitations that differed from claims 35-47.

Applicant further notes that Szeto requires the second user to select a link on the second device because the first device is not even aware of the selection of the link by the second user,

or concerned about what is occurring on the second device. Thus, it would be contradictory to the invention disclosed in Szeto for the second device to obtain or receive the media content item without user input via the second device. Lee requires the second user (i.e., the user at the invitee computer) to acknowledge assent by accepting an invitation because the invention is focused on a shared audio experience. It would thus be inconsistent with Lee to force the second user to listen to music that the second user has no desire or interest to listen to. Consequently, not only do Szeto and Lee fail to teach or suggest Applicant's claimed invention, but it would not be obvious in view of Szeto and/or Lee to direct a second device to obtain or receive a media item without user input via the second device because such action would directly conflict with the goals of either invention. For at least the foregoing reasons, Applicant submits that neither Szeto or Lee, either alone or in combination, render Applicant's claimed invention obvious, and that Applicant's claims 35, 48, 53, 59, 60 and 61 are therefore allowable.

Claims 37-39, 41, 43-47, and 49-52 are dependent claims that depend directly or indirectly from claim 35, 48, or 53, respectively. Claims 37-39, 41, 43-47, and 49-52 are therefore allowable for at least the same reasons set forth above with respect to claims 35, 48, and 53. However, Applicant reserves the right to further address the rejection of claims 37-39, 41, 43-47, and 49-52 in the future, if needed.

Applicant's new claim 62 recites a further aspect of Applicant's invention wherein the first device is a remote control device that is not capable of playing the media item corresponding to the at least one media item name. Applicant submits that neither Szeto nor Lee disclose such an invention, nor would either invention work without a first device that plays the media item. In Szeto, the first device must play the media item because it is by virtue of the first device playing the media item that the second device is even aware of the media item. In Lee, the first device must play the media item because the invention is focused on a shared audio experience, and there could be no shared audio experience unless both devices were capable of playing the media item. Thus, Applicant submits claim 62 is allowable over Szeto and Lee.

Conclusion

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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